

REMARKS

By this Amendment, Applicant has amended claims 1, 35, and 38; canceled claims 34, 36, and 41 without prejudice or disclaimer; and added new claims 42 and 43. No new matter has been added. Claims 1-33, 35, 37-40, 42, and 43 are present in the application. Of those claims, claims 26-30 and 33 have been withdrawn from consideration as being non-elected. New claims 42 and 43 are readable on the previously elected species of Fig. 1.

I. Acknowledgement of Election

In the Office Action, Applicant's election of Species 1 (Fig. 1) in the Response to Election of Species Requirement filed November 2, 2005, has been acknowledged. The Office Action dated October 4, 2005, indicated that Applicant's independent claim 1 is generic. Applicant respectfully submits that at least independent claim 38 is also generic, and respectfully requests acknowledgment that independent claim 38 is generic.

II. Rejections of Independent Claims under 35 U.S.C. § 102(b)

The only independent claims pending in the present application are independent claims 1 and 38. In the Office Action, Applicant's independent claim 1 was rejected under 35 U.S.C. § 102(b) in separate rejections based on each of the following references: Walters et al. (U.S. Patent No. 5,527,577), Gueret (U.S. Pat. Pub. No. US 2001/0033766), and Console et al. (U.S. Patent No. 4,145,291). Furthermore, Applicant's independent claim 38 was rejected under 35 U.S.C. § 102(b) based on

Prescott (U.S. Patent No. 5,728,157). By this Amendment, Applicant has amended independent claims 1 and 38, and each of those independent claims is patentably distinguishable from Walters et al., Gueret, Console et al., and Prescott, regardless of whether those references are viewed individually or in combination.

A. Amended Independent Claim 1

Applicant's amended independent claim 1 recites a device for at least one of packaging and dispensing at least one of a cosmetic product and a beauty care product, including, among other recitations, "a receptacle containing at least one of a cosmetic product and a beauty care product; and at least one body . . . wherein the at least one body is not in the form of a dip tube."

1. Section 102(b) Claim Rejection based on Walters et al.

In the Office Action, Applicant's independent claim 1 was rejected under 35 U.S.C. § 102(b) based on Walters et al. The rejection statement asserts that Walters et al. "discloses a dispenser 410 comprising a receptacle 412, and a body comprising a binder (absorbent material 460), a plurality of particles (flexible eduction tube material 424), and a cavity (formed by the opening at the free end of the tube 430)." Office Action at 2. The rejection statement further asserts that "it is reasonable to construe the absorbent material 460 as the binder and the tube material 424 as the particles given the cross sectional area of the two respective layers shown in the alternative embodiment of Figures 21 and 23 which shows more absorbent material than tube material," and that "in the extruded-together configuration, the

uniform mixture discussed in col. 12, lines 6-14 ensures that both the body and some of the particles will inherently touch the product within the dispenser.” Id. at 2-3.

Notwithstanding the rejection statement’s assertions, Walters et al. neither discloses nor suggests at least a device for at least one of packaging and dispensing at least one of a cosmetic product and a beauty care product, including, among other recitations, “a receptacle containing at least one of a cosmetic product and a beauty care product; and at least one body . . . wherein the at least one body is not in the form of a dip tube,” as recited in Applicant’s amended independent claim 1. Regardless of the rejection statement’s assertion about Walter et al. purportedly disclosing “a body comprising a binder (absorbent material 460), a plurality of particles (flexible eduction tube material 424), and a cavity (formed by the opening at the free end of the tube 430),” the Walters et al. reference does not disclose at least the above-outlined subject matter recited in Applicant’s independent claim 1. For at least this reason, Applicant’s independent claim 1 is patentably distinguishable from Walters et al.

2. Section 102(b) Claim Rejection based on Gueret

In the Office Action, Applicant’s independent claim 1 was rejected under 35 U.S.C. § 102(b) based on Gueret. Applicant respectfully submits that the § 102(b) rejection based on Gueret is improper for a number of reasons. For example, the rejection statement asserts that Gueret “discloses a dispenser 1 comprising a receptacle 4, a body 13 comprising a binder of polyether (para. 108) or ceramic (para. 113) with cavities (the open cells discussed in para. 32) and a plurality of particles (ferrite particles discussed in paragraph 40), and in such configuration, the

uniform distribution of particles disused in para. 70 ensures that some of the particles will touch product once the product is applied to the body.” Office Action at 3.

Without addressing the accuracy of the rejection statement’s assertions about what Gueret discloses, Applicant respectfully traverses the § 102(b) rejection of independent claim 1 based on Gueret because it refers to portions of the Gueret reference that relate to features of different embodiments and does not explain how Gueret purportedly discloses combining all of those features in the manner asserted by the rejection statement.

In order to anticipate a claim, “[a] reference must teach every element of the claim.” M.P.E.P. § 2131. Furthermore, it is well settled that in order to anticipate a claim, “every element of the claimed invention must be identically shown in a single reference,” and that “[t]hese elements must be arranged as in the claim . . .” See In re Bond, 910 F.2d 831, 832, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990) (emphasis added) (cited in relevant part in M.P.E.P. § 2131). In addition, a reference does not anticipate a claim if it merely discloses all of the individual elements of a claim, but fails to disclose the part-to-part relationship of those individual elements, as recited in the claim. See Lindemann Maschinenfabrick GMBH v. American Hoist and Derrick Co., 730 F.2d 1452, 1459, 221 U.S.P.Q. 481, 485 (Fed. Cir. 1984). Furthermore, “[t]here is no anticipation unless ‘all of the same elements are found in exactly the same situation and united in the same way . . . in a single reference.’” Perkin Elmer Corp. v. Computervision Corp., 732 F.2d 888, 894, 221 U.S.P.Q. 669 (Fed. Cir. 1984) (citation omitted) (emphasis added). Because the rejection statement fails to explain how the Gueret reference

purportedly discloses all of the elements in the same arrangement recited in independent claim 1, the § 102(b) rejection based on Gueret is improper.

In addition to the § 102(b) claim rejection based on Gueret being improper for the above-outlined reasons, the rejection is also improper because it fails to even assert that Gueret discloses all of the subject matter recited in Applicant's independent claim 1. For example, the rejection statement fails to assert that Gueret discloses a device including at least one body, "wherein the at least one body defines at least one cavity visible to the naked eye," as recited in independent claim 1.

For at least the above-outlined reasons, Applicant's amended independent claim 1 is patentably distinguishable from the Gueret reference.

3. Section 102(b) Claim Rejection Based on Console et al.

In the Office Action, independent claim 1 was rejected under 35 U.S.C. § 102(b) based on Console et al. The rejection statement asserts that Console et al. "discloses a dispenser comprising a receptacle (14 and 11) and a body comprising a ceramic binder 21 (see col. 2, lines 44-48) with a plurality of silver particles which are released as ions when water passes through the body (see col. 4, lines 29-50) and a cavity (see concave portion of body in Figure 3)." Office Action at 4. Applicant respectfully traverses the § 102(b) rejection of independent claim 1 because Console et al. fails to disclose or suggest all of the subject matter recited in Applicant's amended independent claim 1.

For example, Applicant's amended independent claim 1 recites a device for at least one of packaging and dispensing at least one of a cosmetic product and a beauty

care product, including, among other recitations, “a receptacle containing at least one of a cosmetic product and a beauty care product” The Console et al. reference does not disclose or suggest at least that subject matter recited in Applicant’s amended independent claim 1. Rather, Console et al. discloses an apparatus for disinfecting drinking water dispensed from a drinking water dispenser (see Fig. 1). For at least this reason, Applicant’s amended independent claim 1 is patentably distinguishable from Console et al.

B. Amended Independent Claim 38

In the Office Action, independent claim 38 was rejected under 35 U.S.C. § 102(b) based on Prescott. Applicant respectfully submits that amended independent claim 38 is patentably distinguishable from Prescott because Prescott does not disclose or suggest all of the subject matter recited in amended independent claim 38.

Applicant’s amended independent claim 38 recites a method for manufacturing a device for at least one of packaging and dispensing at least one of a cosmetic product and a beauty care product, the method including, among other recitations, “providing at least one body . . . ; and inserting the at least one body into a receptacle of a device for at least one of packaging and dispensing at least one of a cosmetic product and a beauty care product.” The Prescott reference does not disclose or suggest at least that subject matter recited in amended independent claim 38. Rather, Prescott discloses prostheses of predetermined shapes designed for non-percutaneous implantations in a living body.

Applicant notes that the Office Action acknowledges that Prescott does not disclose at least the above-outlined subject matter recited in amended independent claim 38. In particular, the Office Action concedes that Prescott “does not disclose the step of inserting the body into a receptacle for packaging and dispensing a cosmetic product.” Office Action at 8. The Office Action asserts, however, that “[i]t would have been obvious to add the method step of inserting the body [(i.e., the prosthesis of Prescott)] into a receptacle which is capable of packaging and dispensing a cosmetic product to the Prescott method in view of Will for convenient packaging and dispensing of the prosthesis disclosed by Prescott.” Id.

The above-outlined assertions included in the Office Action apparently relate to the Office Action's rejection of dependent claim 41 under 35 U.S.C. § 103(b) based on Prescott in combination with Will (U.S. Patent No. 4,697,703). Applicant respectfully traverses that rejection because it fails to establish a *prima facie* case of obviousness at least because neither Prescott nor Will discloses or suggests “[a] method of manufacturing a device for at least one of packaging and dispensing at least one of a cosmetic product and a beauty care product . . . ,” as recited in Applicant's amended independent claim 38.

The rejection statement relating to the § 103(a) rejection of claim 41 asserts that “Will discloses a prosthesis package (see Figures) which is also capable of packaging and dispensing a cosmetic product by virtue of the cavity within the receptacle.” Applicant respectfully submits that the rejection statement is apparently improperly interpreting the recitation, “for at least one of packaging and dispensing at least one of a cosmetic product and a beauty care product,” as a statement of intended use and

relying on that improper interpretation to completely disregard that recitation. Rather than being a statement of intended use that can be effectively ignored, however, the above-mentioned recitation of claim 38 is a positive recitation in a method claim that must be given patentable weight. For at least this reason, it is improper to rely on such apparent intended use assertions for providing a basis to reject Applicant's amended independent claim 38, which is directed to a method. In particular, neither Prescott nor Will discloses or suggests "[a] method of manufacturing a device for at least one of packaging and dispensing at least one of a cosmetic product and a beauty care product . . . ," as recited in Applicant's amended independent claim 38. For at least this reason, amended independent claim 38 is patentably distinguishable from Prescott and Will, regardless of whether those references are viewed individually or in combination.

III. Claim Rejections of Dependent Claims

In the Office Action, claims 2-25, 31, 32, 34-37, and 39-40 were rejected under either 35 U.S.C. § 102(b) based on one of Walters et al., Gueret, Console et al., and Prescott, or under 35 U.S.C. § 103(a) based on one of Walters et al., Gueret, Console et al., and Prescott, either alone or in combination with one or more of the following references: Peled et al. (U.S. Patent No. 4,844,996); Thacker (U.S. Patent No. 4,607,594); Chattha (U.S. Patent No. 4,611,046); Brahm et al. (U.S. Patent No. 6,001,931); Anello et al. (U.S. Patent No. 3,758,543); Leech (U.S. Patent No. 4,287,253); and McAuslan (U.S. Patent No. 4,836,884). Each of claims 2-25, 31, 32, 34-37, and 39-40 depends from one of independent claims 1 and 38. Accordingly,

each of those dependent claims should be allowable for at least the same reasons independent claims 1 and 38 are allowable.

IV. New Dependent Claims 42 and 43

By this Amendment, Applicant has added new dependent claims 42 and 43. Claims 42 and 43 respectively depend from independent claims 1 and 38. Therefore, dependent claims 42 and 43 should be allowable for at least the same reasons independent claims 1 and 38 are allowable.

V. Conclusion

For at least the reasons set forth above, independent claims 1 and 38 should be allowable. Dependent claims 2-33, 35, 37, 39, 40, 42, and 43 (including withdrawn claims 26-30 and 33) depend from one of independent claims 1 and 38. Therefore, those dependent claims should be allowable for at least the same reasons the independent claims from which they depend are allowable.

Applicant respectfully requests reconsideration of this application, withdrawal of the outstanding claim rejections, and allowance of claims 1-33, 35, 37-40, 42, and 43.

If the Examiner believes that a telephone conversation might advance prosecution, the Examiner is cordially invited to call Applicant's undersigned attorney at (571) 203-2739.

Applicant respectfully submits that the Office Action contains numerous assertions concerning to the related art and the claims. Regardless of whether those

assertions are addressed specifically herein, Applicant declines to automatically
subscribe to those assertions.

Please grant any extensions of time required to enter this response and charge
any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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